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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/085,213 | 02/28/2002 | Shinichi Sato | 11301-1481 | 8571 |

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| EXAMINER | |
|---|---|
| SERGENT, RABON A | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1711 | |

DATE MAILED: 06/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/085,213 | SATO ET AL. | |
| | Examiner | Art Unit | |
| | Rabon Sergent | 1711 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *02 May 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *46-50* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *46-49* is/are allowed.

6)☒ Claim(s) *50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/242,525.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 2, 2006 has been entered.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baghdachi et al. ('224).

Patentees disclose moisture curable polyurethane compositions comprising silane-capped polyurethanes, wherein the silane-capped polyurethane is produced by reacting a mixture of a polyol, a diisocyanate, and an amino-functional silane. Furthermore, patentees' definition of U, as it appears within the structure for the silane capped polyurethane, requires no more than two

urethane linkages; therefore, patentees' silane capped polyurethanes clearly encompass compounds that correspond to those of applicants. In other words, U need not be derived from polyurethane prepolymers having multiple urethane groups. Additionally, in view of patentees' disclosure that A may be =NH, patentees are considered to disclose that the amino group of the amino-functional silane may be a primary amine. See column 2, line 24 through column 3, line 12.

4. As aforementioned, Baghdachi et al. disclose that the silane capped polyurethane is produced by reacting a mixture of a polyol, a diisocyanate, and an amino-functional silane; therefore, patentees fail to disclose a process wherein the diisocyanate is initially reacted with the amino-functional silane to yield an intermediate, which is then reacted with the polyol. Still, the position is taken it would have been obvious to initially react the diisocyanate and the amino-functional silane to yield the aforementioned intermediate, as opposed to reacting all reactants in one step, because one of ordinary skill would have expected the same final product to result, given that the reaction of amine groups, especially primary amine groups, with isocyanate groups occurs more rapidly than and in preference to the reaction of hydroxyl groups with isocyanate groups. Since the position is taken that the respective processes yield the same product and the only difference amounts to how the polyol is incorporated into the final product, the situation is considered to be analogous to changing the sequence of steps in a multi-step process, and it has been held that such a modification is obvious where an unexpected result is not obtained. *Ex parte Rubin* (POBA 1959) 128 USPQ 440; *Cohn v. Comr. Pats.* (DCDC 1966) 251 F Supp 378, 148 USPQ 486. It has further been held that the selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results. *In re Burhans*, 154

F.2d 690, 69 USPQ 330 (CCPA 1946). Similarly, it has been held that the selection of any order of mixing ingredients is *prima facie* obvious. *In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930). Furthermore, it has been held that a two step combination employing two obvious process steps is unpatentable when each lends properties to the final product known to be produced when the step is practiced alone, in the absence of evidence of coaction between the steps which produce an unobvious result. *In re Fortress*, 369 F2d 1009, 152 USPQ 13 (CCPA 1966). Therefore, the position is ultimately taken that it would have been *prima facie* obvious to modify the reaction sequence of the prior art so as to arrive at the instant process.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

RABON SERGENT
PRIMARY EXAMINER

R. Sergent
June 19, 2006